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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/635,773

08/06/2003

Sidney L. Bursten

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06/30/2006

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EXAMINER

ROHWER, JACOB P

ART UNIT

PAPER NUMBER

2625

DATE MAILED: 06/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/635,773	BURSTEN, SIDNEY L.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jacob P. Rohwer	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-57 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-3, 8-11, 13-18, 20-22, 35-36, 39-40, and 43-45** are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No 6,377,963 to Walker et al in view of US Patent No 5,114,128 to Harris, Jr et al.

Regarding claim 1, Walker discloses a booklet system (**Fig 1 and 2**) comprising:

a pre-printed custom booklet component selected for a targeted recipient; and (**Col 8 Lin 35-39**)

a content controller. (**Fig 2 #200, Col 8 Lin 13-25**)

Although Walker discloses printing indexes and address information on a pre-printed customized cover attached to a magazine, Walker does not expressly disclose the cover having a content control identifier, wherein the content controller disclosed in Walker is adapted to:

use the content control identifier received from the pre-printed custom booklet component to obtain instructions associated with the targeted recipient; and

Art Unit: 2625

use the instructions to marry the pre-printed custom booklet component and the just-printed custom booklet component to produce a customized booklet for the target recipient.

However, Harris, Jr discloses an apparatus for personalizing magazines, wherein a content controller (**Fig 1 #22**) is adapted to:

use a content control identifier (**Col 9 Lin 15 "Barcode Information"**) received from the pre-personalized booklet component to obtain instructions associated with the targeted recipient; and

use the instructions to marry the booklet component and the just-printed custom booklet component to produce a customized booklet for the target recipient. (**Col 9 Lin 15-22 and Col 7 Lin 6-12 discloses that the coded information provides directions for matching subscriber information to the pre-personalized booklet component. Note the marrying of the two components (the pre-personalized signature or cover and the address information) can be interpreted to be direct printing (just-printed component) on the cover of the magazine or can be the adhering of a pre-printed address labels as disclosed in Harris, Jr Col 6 Lin 35-39**)

The Walker and the Harris, Jr Patents are combinable because they both come from the same field of endeavor relating to printing customized information on a magazine.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to use the content control identifier to match pre-personal signatures with a specific magazine as specified in Harris, Jr, in order to output

Art Unit: 2625

the customized booklet cover attached to a magazine using the content controller as specified in Walker.

The suggestion motivation for doing so would have been to provide a reliable matching process of pre-personalized identifiers and address information to be printed on its cover. **(Harris, Jr Col 3 Lin 55-61)**

Therefore it would have been obvious to combine the Walker and the Harris, Jr Patents in order to obtain the invention of claim 1.

Regarding claim 2, the combination further discloses in Harris, Jr the booklet system of claim 1, wherein the content control identifier is a machine-readable code. **(Fig 2 #56, Col 9 Lin 6-7)**

Regarding claim 3, the combination further discloses in Harris, Jr the booklet system of claim 1, wherein the system further comprises a feeder/scanner adapted to receive the pre-printed custom booklet component, to read the content control identifier, and to send the content control identifier to the content controller. **(Col 4 Lin 24-43)**

Regarding claim 8, the combination further discloses in Walker, the booklet system of claim 1, wherein the booklet system is a periodical. **(Col 2 Lin 22-30)**

Regarding claim 9, please see rejection of claim 1 above. Additionally, the combination of Walker and Harris, Jr specifies the booklet system as disclosed in claim 1 including marrying a pre-printed custom booklet component selected for a target recipient **(The “outer wrap” in Walker Col 8 Lin 35-39)**, a pre-printed generic booklet component **(The “magazine” disclosed in Walker Col 8 Lin**

Art Unit: 2625

**38-39), and the just-printed custom booklet component (The “address information” printed on the cover disclosed in Harris, Jr Col 9 Lin 15-22), to produce a customized booklet for the targeted recipient.**

Regarding claims 10-11, please see rejections of claims 9 and 2-3 above.

Regarding claim 13-14, the combination further discloses the booklet system of claim 9 wherein the content control identifier is associated with profile data (claim 13), and the profile data is an address (claim 14) of the targeted recipient **(Harris, Jr Col 9 Lin 15-22)** and wherein the pre-printed generic booklet component is selected from a set of pre-printed generic booklet components for inclusion in the customized booklet using the profile data. **(Walker Fig 2 #251, Col 4 Lin 53-65 discloses the storage of multiple magazines published by the specific publisher and Col 8 Lin 26-35 discloses that data corresponding to one of the magazine stored in the magazine database is transmitted to the fulfillment house for printing.)**

Regarding claim 15, please see rejections of claims 9 and 8 above.

Regarding claim 16, please see rejections of claims 1 and 9 above.

Furthermore, the combination discloses in Harris, Jr one or more pre-printed targeted generic booklet components **(Col 1-2 Lin 67-68 and 1-20, Advertisements)** that can be associated and inserted according to the targeted recipient of the customized magazine printed. **(Col 6-7 Lin 64-69 and 1-12)**

Regarding claims 17-18, please see rejections of claims 16 and 2-3 above.

Art Unit: 2625

Regarding claims 20-21, please see rejections of claims 16 and 13-14 above.

Regarding claim 22, please see rejections of claims 16 and 8 above.

Regarding claim 35, please see rejections of claims 1-3 above. All the limitations specified in claim 35 are included in the rejection of claims 1-3.

Regarding claim 36, please see the rejection of claims 35 and 9 above.

Regarding claims 39-40, please see rejections of claims 1 and 2 above. Additionally the system of claims 1 and 2 performs the methods of claims 39 and 40.

Regarding claim 43, please see rejection of claims 39 and 16 above.

Regarding claims 44-45, please see rejections of claims 39 and 13-15 above.

**Claims 4-7, 12, 19, 23-34, 37-38, 41-42, and 46-57** are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Walker and Harris, Jr as specified in claim 1 above, and further in view of US Patent No 5,875,383 to Stemmler.

Regarding claim 4, the combination of Walker and Harris, Jr discloses the booklet system of claim 1.

The combination does not expressly disclose that the pre-printed custom booklet component comprises one or more signatures printed on a *web-fed printer* and the just-printed custom booklet component comprises a cover printed on a *sheet-fed printer*.

However Stemmler discloses a printing system in which web printing or sheet printing can be used according to the output mode. **(Col 1 Lin 10-15)**

The combination of Walker and Harris, Jr and the Stemmler Patent are combinable because they both come from the same field of endeavor relating to customized printing.

At the time of the invention it would have been obvious to one of ordinary skill in the art, to produce the one or more signatures as specified in the combination of Walker and Harris, Jr **(Harris, Jr Col 1 Lin 8-14)**, using the web-fed mode as specified in Stemmler when the output requires mass printing of the customized signatures, and using the cut sheet printing when providing the cover.

The suggestion/motivation for doing so would have been using the web-printing when capable for lower cost and more reliable long production runs, and using the cut-sheet for printing unique intermixed substrates such as covers.

**(Stemmler Col 1 Lin 20-24)**

Therefore, it would have been obvious to combine the Stemmler Patent with the combination of Walker and Harris, Jr in order to obtain the invention as specified in claim 4.

Regarding claim 5, please see rejection of claims 1, 4 and 9 above.

Regarding claims 6-7, please see rejections of claims 5, 13 and 14 above.

Regarding claim 12, please see rejection of claims 9 and 4 above.

Regarding claim 19, please see rejection of claims 16 and 4 above.

Regarding claim 23, please see rejections of claims 1 and 4 above.



Art Unit: 2625

Regarding claims 24-25, please see rejections of claims 23 and 2-3 above.

Regarding claims 26, please see rejections of claims 23 and 14 above.

Regarding claim 27, the combination further discloses in Harris, Jr that the personalized content is a message. **(Col 1-2 Lin 67-68 and 1-20, Targeted**

**Advertisements are Printed)**

Regarding claim 28, please see rejections of claims 23 and 13-14.

Regarding claims 29, please see rejections of claims 23 and 14 above.

Regarding claim 30, please see rejection of claim 1 above, note the personalized just-printed component and the just-printed custom booklet component can be the same component.

Regarding claim 31, please see rejection of claims 23 and 4 above.

Regarding claim 32, please see rejection of claims 31 and 9 above.

Regarding claim 33, please see rejection of claims 32 and 13 above.

Regarding claim 34, please see rejection of claims 23 and 15 above.

Regarding claim 37, please see rejection of claims 23 and 2-3 above.

Regarding claim 38, please see rejection of claims 37 and 9 above.

Regarding claim 41, please see rejection of claims 39 and 4 above.

Regarding claim 42, please see rejection of claims 41 and 9 above.

Regarding claim 46, please see rejection of claims 1 and 4 above.

Additionally the system of claims 1 and 4 performs the method of claim 46.

Art Unit: 2625

Regarding claims 47-57, please see rejections of claims 24-34 above respectively. Additionally the system of claims 24-34 performs the methods of claims 47-57.

### ***Response to Arguments***

Applicant's arguments filed 11 April 2006, with respect to the Hara and Grady references have been fully considered and are persuasive. The rejection based on the cited references has therefore been withdrawn.

Applicant's arguments with respect to claims 1-57 have been considered but are moot in view of the new ground(s) of rejection. Examiner reminds applicant that due to the withdrawal of the previous rejection, and the new submission of cited prior art, this action is made non-final.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob P. Rohwer whose telephone number is 571-272-5509. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on 571-272-7471. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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